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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,171	02/01/2002	Brian Samuel Beaman	YOR919960186US2	3582
7590 03/20/2009				
Dr. Daniel P. Morris, Esq. IBM Corporation Intellectual Property Law Department P.O. Box 218 Yorktown Heights, NY 10598				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
03/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/066,171	Applicant(s) BEAMAN ET AL.
Examiner WILLIAM T. LEADER	Art Unit 1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 2/24/09 & 2/25/09 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 49, 66, 81, 86, 88, 90-94 and 96.
Claim(s) withdrawn from consideration: 50-60, 67-80, 82-85, 87, 89, 95 and 97-102.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/PATRICK RYAN/
Supervisory Patent Examiner, Art Unit 1795

Continuation of 3. NOTE: In the paper filed on February 24, 2009, applicant proposes amending the dependency of claim 92. This amendment would change the scope of the claim. This change would necessitate further consideration and a possible new ground of rejection. In the paper filed on February 25, 2009, applicant proposes amending claim 94. Claim 94 as proposed does not reflect the amendment to claim 94 made by applicant in the paper filed on August 17, 2006.

Continuation of 13. Other: At page 10 of applicant's response filed on February 24, 2009, applicant requests withdrawal of the final rejection. In the first office action on the merits, claims 49 and 50, the only claims under consideration were rejected. In the response filed by applicant, new claims 66-102 were presented. The new grounds of rejection included in the final office action mailed on November 26, 2008, were directed to the newly presented claims. Consequently, the finality of the action was proper.

At pages 11 and 12 of the Remarks filed on February 24, 2009,, applicant argues that Eldridge is not prior art because there is no teaching of how the dielectric material can be applied over the nickel layer 1092, and the structure of Eldridge figure 10k is not enabled. This argument is not convincing. As stated in MPEP 2121 I, prior art is presumed to be operable/enabling. The burden is on applicant to provide facts rebutting the presumption of operability. One of ordinary skill in the art would have recognized that the dielectric material could have been applied by a coating process, and would have been capable of performing such a coating process without undue experimentation. Applicant has provided no facts to show otherwise.